REMARKS

Claims 1-16 are all of the pending claims, with claims 1 and 9 being written in independent form. By this Amendment, claims 1 and 9 are amended. No new matter is added.

Rejection under 35 USC §112:

In the Decision on Appeal, the previous rejection of the pending claims under 36 USC §103 is reversed and a new grounds of rejection is entered rejecting the pending claims under 35 USC §112, second paragraph. Specifically, the claims are rejected for allegedly claiming a "future act" due to the phraseology of "a plurality of automation objects which are to be created and worked on, each automation object realizing a partial automation solution."

To particularly point out and distinctly claim the subject matter which Applicants regard as the invention, independent claims 1 and 9 are amended to remove the language interpreted as purporting to a "future act."

As the claims are amended to overcome the rejection of the Board of Patent Appeals and Interferences, withdrawal of the rejection is respectfully requested.

Rejections in view of previously Applied References:

The combination of Weinberg and Bentley fail to disclose or suggest the features of the claims as amended. For example, Weinberg relates to software tools for load testing websites and other types of client server systems according to browsing behaviors of typical users of the websites (col. 1, lines 27-32). Thus, Weinberg provides a test generation tool that eliminates the need for a user to browse the website or actively define a user scenario by providing a software module and an associated method for automatically generating test scenarios based on information stored within a server access log file. The log files typically include IP addresses of the visitors, i.e., the uniform resource locators (URL's) that were accessed, and the times and dates of the accesses (col. 2, line 66-col. 3, line 15).

Specifically, Weinberg provides an Astra Site Manager ™ program (Astra) that includes features for facilitating the mapping, analysis (including load testing) and management of websites. Given the address of the websites home page, Astra automatically scans the website

and creates a graphical site map showing all of the URLs of the site and the links between these URL's. The layout and display method used by Astra for generating the site map provides a highly intuitive, graphical representation which allows the user to visualize the layout of the site. Using the mapping feature, in combination with Astra's integrated tools for navigating filtering and manipulating the website map, users can intuitively perform such actions as isolating and repairing broken links, focusing in on web pages (and other content objects) and a particular content type and/or status, and highlight modifications made to a website since a prior mapping (col. 7, lines 41-59). Thus, the system of Weinberg merely scans websites and creates a graphical site map which can be worked on as described above. The websites are not automation objects.

Further, Weinberg fails to disclose or suggest a "plurality of automation objects which are alterable by a user, each automation object realizing a partial automation solution." Figure 8 of Weinberg illustrates an object model used by Astra that includes six classes of objects which are implemented as OLE Automation objects (Astra, Site Graph, Edges, Edge, Nodes and Node). The Astra object 94, for example accesses and manipulates data stored by a Site Graph object 114. The Site Graph object corresponds generally to a map of the website and includes information about the URL's and links of the website.

Although Weinberg discloses the use of OLE Automation objects, merely disclosing the use of automation objects does not correspond to "a plurality of automation objects which are alterable by a user, each automation object realizing a partial automation solution," as recited in rejected claims. Rather, in Weinberg, the OLE Automation objects are already created and are not available to be altered by the user of the software. In other words, there is no alteration of an automation object to realize a partial automation solution. Instead, the OLE Automation objects of Astra have already been created and are merely used as tools for their intended purposes by Astra for showing a graphical display of a website.

It is further alleged, that Weinberg shows "a directory for entering and storing object names of the automation objects" as recited in the amended claims. However, Weinberg does not show any directory for entering or storing names of the graphical site maps as automation objects. For example, Fig. 3 of Weinberg merely shows a created graphical map of a website where complex web structures and the interrelationship between data entries of those structures are displayed in such a way that makes navigation for the user easier. Information data with

respect to references in the form of URL's and interfaces in the form of links disclosed by Weinberg as possible further information data do not refer to the graphical site maps as the automation objects, but to the content of the website scanned by Weinberg's system. Thus, Weinberg fails to disclose all of the claimed features as alleged.

Applicants respectfully submit that there is no motivation or suggestion to combine the Bentley with Weinberg. The motivation or suggestion to combine a reference or modify the primary reference must both be found in the prior art, and not based on Applicants disclosure (see MPEP § 2143). The availability of the prior art reference for combination with other references depends on determining whether the particular references are within the appropriate scope of art (In re Wood, 599 F. 2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)). Determination of whether a reference is within the appropriate scope of the art may be determined by whether the references are reasonably pertinent to the particular problem with which the inventor was involved (In re Diminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986)).

As discussed above, Weinberg relates to software systems and methods for generating a load test that allows a website to be tested according to the browsing behaviors of typical users. The problem being addressed in Weinberg are difficulties in managing website content and maintaining website effectiveness due to a wide array of burdensome tasks, including for example, the identification and repair of large numbers of broken links (i.e., links to missing URL's), monitoring and organizing large volumes of diverse, continuously-changing website content, and a detection of management congested links (col. 1, lines 36-45 or Weinberg).

In contrast, Bentley relates to computerized modeling, such as computer aided design (CAD) used in geometry-orientated engineering. Bentley seeks to resolve problems known to exist in such 2-d and 3-d modeling of the physical properties of a design that occur as a result of a lack of correlation with the geometric properties and the most efficient strategy for organizing and storing the model information. For example, because modeling data from different domains may be simultaneously required in arbitrary combination by a user, multiple unrelated demands specific tools can not be employed (col. 1, lines 18-57 of Bentley). Because the problem being addressed in Bentley cannot be determined to be reasonably pertinent to the particular problem

being addressed by Weinberg, the references cannot be combined to determine the patentability of the Applicants claims (In re Clay, 966 F. 2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992)).

CONCLUSION

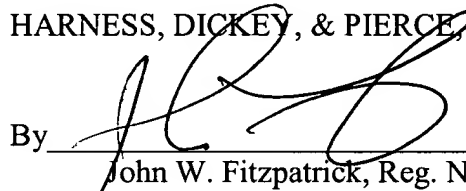Reconsideration and allowance of claims 1-16 is earnestly solicited.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John Fitzpatrick at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By

John W. Fitzpatrick, Reg. No. 41,018

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

DJD/JWF